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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,101	01/24/2002	Leonard Marotta	MAROTTA-ANALOG	9440
4988	7590	07/02/2004	EXAMINER	
ALFRED M. WALKER 225 OLD COUNTRY ROAD MELVILLE, NY 11747-2712			LEWIS, RALPH A	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/056,101	Applicant(s) MAROTTA, LEONARD	
	Examiner Ralph A. Lewis	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12, 14-17, 19, 21-24, 30, 32-35 and 38-41 is/are allowed.
- 6) ☒ Claim(s) 1-11, 13, 18, 20, 25-29, 31 and 37 is/are rejected.
- 7) ☒ Claim(s) 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Objections to the Drawings/Specification

Applicant's proposed drawing correction of 07/25/2003 is approved by the examiner, formal drawings are required. Additionally, the specification's description of the drawings must be amended to reflect the additional Figures.

Rejections based on Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7, 9-11, 13, 18, 20, 25-29, 31 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Carlsson et al (5,125,841).

Carlsson et al disclose an anti-rotation dental analog post comprised of an elongated pin 5 with an anti-rotation radial projection 6' extending from an end thereof. It is noted that whether the projection 6' is at the "bottom end" or "top end" depends entirely on the orientation of the dental mold, if used while taking an impression mold of the upper jaw then the radial projection would be at the "bottom end" (assuming the patient is sitting upright). In regard to claim 3, technically according to the definition of an ellipse a circle is an ellipse. In regard to claim 7, a cross section through that part of the elongated pin 5 at 6 would provide for a rectangular cross-section. In regard to claims 25 and 26, note

Art Unit: 3732

receptacle sleeves 1, 2. In regard to claim 27, the Carlsson et al mounting pin is inserted with end 6' into an "impression spoon" (column 3, lines 30, 31)(the claimed "casting mold"), secured in place by that attachment to the spacer elements and the radial extensions 6', 6 are embedded in the impression molding material and counteract an unintentional turning of the impression top (note column 3, lines 21 and 22).

In response to the present rejection of the apparatus claims, rather than pointing to a claimed structural element that distinguishes the claimed device from the prior art Carlsson et al device, applicant argues that he intends for the claimed device to be used differently than the disclosed use of the prior art. It is well settled, however, that merely defining a new use for an old and known device does not make that old and known device patentable. In regard to the method claims 27-29, the examiner suggests making it clear in the claims that applicant calls for the construction of a model of a patient's dentition in which the analog is secured/set and that it is from this model with the analog set therein that the crown is to be prepared.

Claims 1-3, 9, 10, 11, 18 and 25-29 rejected under 35 U.S.C. 102(b) as being anticipated by Sutter (WO 98/52490) (note US 6,332,77 B1 is relied upon herein as an accurate translation of the PCT application).

In Figure 1, note analog post 50 with anti rotation anchoring projections between elements 60. Note the remarks above in response to applicant's remarks.

Art Unit: 3732

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlsson et al (5,125,841).

Carlsson et al disclose a circular cross-section for the pin rather than the variety of different geometric cross-sections set forth in the present claims by applicant. One of ordinary skill in the art, however, would have found it obvious to have used other common geometric configurations for the cross-section of the Carlsson et al pin as a matter of routine design.

Claims 1-11, 18 and 25-29 rejected under 35 U.S.C. 103(a) as being unpatentable over Sutter (WO 98/52490) (note US 6,332,77 B1 is relied upon herein as an accurate translation of the PCT application).

In regard to claims 4-8, Sutter discloses a circular cross-section for the pin rather than the variety of different geometric cross-sections set forth in the present claims by applicant. One of ordinary skill in the art, however, would have found it obvious to have used other common geometric configurations for the cross-section of the Sutter pin as a matter of routine design

To the extent that applicant's "analog post" limitation requires an interpretation that the "analog post" is representative of the implant, Sutter discloses such a post 263 (Figures 11-14) having anti-rotation projections 266

Art Unit: 3732

extending radially therefrom for fixing the post in the dental mold. Sutter does not appear to explicitly disclose that these projections 266 (illustrated schematically) can be designed as those projections shown at 60 in Figure 1. One of ordinary skill in the art, however, would have readily found that the design of the projections 60 for preventing rotation could obviously be applied to the projections 266 in order to prevent rotation.

Allowable Subject Matter

Claims 12, 14-17, 19, 21-24, 30, 32-35 and 38-41 are allowed.

Claim 36 is objected to as being written on a rejected base claim but would be allowable if rewritten in independent form to include all of the limitations of the claims from which it depends.


Action Made Final

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(703) 308-0770**. Fax (703) 872-9306. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (703) 308-2582.

R.Lewis
June 25, 2004



Ralph A. Lewis
Primary Examiner
Au 3732